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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES G. SHANAHAN and GREGORY T. GREFENSTETTE

Appeal 2009-001165
Application 09/683,238
Technology Center 2100

Decided: May 24, 2010

Before JOHN A. JEFFERY, JOSEPH L. DIXON, and
JEAN R. HOMERE, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final rejection of claims 1, 3-6, 9-14, 16-18, and 21-26. Claims 2, 7-8, 15, and 19-20 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

I. STATEMENT OF THE CASE

The Invention

The invention at issue on appeal relates to a method and apparatus for operating and controlling a line cache (Spec. 1).

The Illustrative Claim

Claim 1, an illustrative claim, reads as follows:

1. A method for enriching document content, comprising:

storing on an identification tag a personality identifier that is machine readable; the personality identifier identifying a personality in a database of personalities;

recording the personality identifier from the identification tag with a reader;

recording context information with the reader when the personality identifier is recorded; the recorded context information recorded with the reader including time information and position information, which time information includes information identifying when the personality identifier is recorded with the reader and which position information includes information identifying where the personality identifier is recorded with the reader;

identifying document content with the reader using (i) the recorded context information and (ii) metadata recorded recording when and where document content is accessed with the reader; said identifying of document content being based on

when and where (i) the personality identifier is recorded with the reader and (ii) document content is accessed with the reader;

transmitting from the reader the identified document content and the recorded personality identifier to a meta-document server;

associating at the meta-document server the personality identifier with a personality in a database of personalities;

enriching at the meta-document server the identified document content using a set of document service requests identifying enrichment themes that are defined by the associated personality; said enriching recognizing and annotating entities in the identified document content related to the enrichment themes of the associated personality; and

making at the meta-document server the enriched document content available.

The References

The Examiner relies on the following references as evidence:

Reber	US 5,986,651	Nov. 16, 1999
Horowitz	US 6,122,647	Sep. 19, 2000
(hereafter Horowitz'647)		
Horowitz	US 6,236,987 B1	May. 22, 2001
(hereafter Horowitz'987)		
Keith	US 2002/0032672 A1	Mar. 14, 2002
		(filed Mar. 6, 2001)

The Rejections

The following rejections are before us for review:

Claims 1, 3-6, 9, 11-14, 16-18, and 21-26 stand rejected under

35 U.S.C. § 103(a) as being unpatentable over the combination of Horowitz'647, Horowitz'987, and Reber.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Horowitz'647, Horowitz'987, Reber, and Keith.

II. ISSUE

Has the Examiner erred in finding that the combination of Horowitz'647, Horowitz'987, and Reber teaches or fairly suggests “the recorded context information recorded with the reader including time information and position information, which time information includes information identifying when the personality identifier is recorded with the reader and which position information includes information identifying where the personality identifier is recorded with the reader,” and “identifying of document content being based on when and where (i) the personality identifier is recorded with the reader and (ii) document content is accessed with the reader;” as recited in claim 1?

III. PRINCIPLES OF LAW

Scope of Claim

During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation, and the scope of a claim cannot be

narrowed by reading disclosed limitations into the claim. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). The Office must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citing *In re Bass*, 314 F.3d 575, 577 (Fed. Cir. 2002)).

“Giving claims their broadest reasonable construction ‘serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.’” *Id.* (quoting *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984)). “Construing claims broadly during prosecution is not unfair to the applicant . . . because the applicant has the opportunity to amend the claims to obtain more precise claim coverage.” *Id.*

Obviousness

“Obviousness is a question of law based on underlying findings of fact.” *In re Kubin*, 561 F.3d 1351, 1355 (Fed. Cir. 2009). The underlying factual inquiries are: (1) the scope and content of the prior art, (2) the differences between the prior art and the claims at issue, (3) the level of ordinary skill in the pertinent art, and (4) secondary considerations of nonobviousness. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (citation omitted).

IV. FINDINGS OF FACT

The following findings of fact (FFs) are supported by a preponderance of the evidence.

Specification

1. The Specification describes that “electronic tag and tag reader systems can be based on temporary direct connection between a tag and a computing system.” (Spec. 19).

2. The Specification also describes that “[a] ‘personality’ is used to mean a thematic set of services that can be applied to enrich a document.”

Reber

4. Reber discloses a method and system of “a network navigation device for automatically linking a user to a resource in an electronic network.” (Col. 3, ll. 17-21). Reber also discloses that a card shaped structure having a machine readable data to allow a user link to the resource (a website or a server). (Col. 13, ll. 14-33, col. 14, 54-67).

5. Reber further discloses a date and time at which “the resource was visited or the hard copy output was printed.” (Col. 15, ll. 6-8, Fig. 14).

6. Reber also discloses that the additional information can include a human-reviewable form of the electronic address printed on the card. (Col. 15, ll. 3-6).

7. Reber also discloses the human viewable image representation 59 or machine readable representation 56 for a location URL to access or

browsing the content of documents. (Col. 7, l. 59-col. 8, l. 15; Col. 16, ll. 1-6).

V. ANALYSIS

Appellants have the opportunity on appeal to the Board of Patent Appeals and Interferences (BPAI) to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The Examiner sets forth a detailed explanation of a reasoned conclusion of unpatentability in the Examiner's Answer. Therefore, we look to the Appellants' Brief to show error in the proffered reasoned conclusion. *Id.*

Grouping of Claims

The Appellants have elected to argue claims 1, 3-6, 9, 11-14, 16-18, and 21-26 together as a group (App. Br. 9). Therefore, we select independent claim 1 as the representative claim for this group, and we will address the Appellants' arguments with respect thereto. 37 C.F.R. § 41.37 (c)(1)(vii). *See In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

35 U.S.C. § 103(a) Rejections

We start our analysis with claim construction. We broadly, yet reasonably construe the claim limitations in light of the Specification 1) "reader" as any data recording device or data accessing device such as any

card reader or any data access device including a server (FF 1); 2) “personal identifier” as any thematic set of service in either electronic form or human viewable form (FF 2) and the “context information” can also be any information, machine readable or human viewable form; 3) “time information includes information identifying when . . .” as any time information, machine readable or human viewable form, indicating a time because there is no limitation in the claim language to indicating the information has any particular form; 4) “position information includes information identifying where . . .” as any form of position information, machine readable or human viewable form, indicating a location because there is no limitation in the claim language indicating the information has any particular form; and 5) “identifying of document content being based on when and where . . .” as any action identifying /accessing/visiting/viewing of a document (electronic or paper) association or had nexus to when and where information.

With respect to claim 1, Appellants contend that recording a personal identifier with a reader together with context information is not disclosed or suggested. In particular, Reber only concerns the rendering or printing of machine readable data and human viewable data on a network navigation device, the machine readable code can be used to access a network resource (App. Br. 16, Reply Br. 4).

We disagree with Appellants’ contentions. We find Reber teaches that the position information (URL) and time information (time data) are

recorded with the context information (the card) (FF 3, FF 4, and FF 5) in either machine readable form or human viewable form. Further, the personal identifier can be the information stored in the machine readable code and the reader can be a source server under our above claim construction.

Appellants also contend that the combination of Horowitz '647, Horowitz '987, and Reber fails to teach the claimed limitation "time information includes information identifying when the personality identifier is recorded with the reader" recited in claim 1 (App. Br. 10, Reply Br. 3). In particular, Appellants further contend that Reber discloses that "'additional data' in 'human-viewable' form is distinct from 'machine-readable data' appearing on the network navigation device as disclosed and illustrated by Reber." (App. Br. 11). In addition, Appellants further contend that the time information rendered on the Reber's device is when the device is created, i.e., either the network resource is visited or the device is printed (App. Br. 12, Reply Br. 2).

We disagree with Appellants' contentions. We find Reber teaches that the claimed limitation "personal identifier is recorded with the reader" can be read on the digital information of the machine readable code visits the resource such as a server (FF 4) under our claim construction. We also find that the claimed limitation the "time information includes information identifying when. . ." can be read on the teachings of Reber that the date the personal identifier visits (records) the resource (FF 5). Under our claim

construction, it is our view that the time data recorded to indicate when the resources were visited by the personal identifier in machine readable code (FF 5) is the “time information” regardless what the form it may be, machine readable or human viewable.

Appellants further contend that Reber’s position information is only concerned with the position of information rendered on a network navigation device and is not concerned or directed to the recording of position information of context information with a reader (App. Br. 14, second paragraph; Reply Br. 3), and only concerned “where (a) resources are located or (b) a code is located, from which a node identifies a resource (see Reber column 4, lines 2-7).” (Reply Br. 3).

We disagree with Appellants’ contentions. We find that the claimed limitation “the location information includes information identifying where . . .” recited in claim 1 can be read on the teachings of Reber that the location information of the human-reviewable information can be the URL to indicate the location that the personal identifier visits the resource such as a server (FF 6). Under our claim construction, it is our view that the location data (URL) to indicate where the resources is visited (accessed) by the personal identifier in machine readable code (FF 6) is the “position information” regardless what the form it may be, machine readable or human viewable.

Appellants further contend that the Examiner fails to indicate “identifying of document content being based on when and where (i) the

personality identifier is recorded with the reader and (ii) document content is accessed with the reader;” (App. Br. 16, Reply Br. 4).

We disagree with Appellants’ contention. We find Reber teaches that the contents of node (server) can be accessed or browsed according to the location information, i.e., URL, which a personality identifier (information stored in the machine readable code) visits or access (record) with the source server (recorder), under our claim construction (FF 7).

Accordingly, we sustain the Examiner’s obviousness rejection of claim 1. We also sustain the Examiner’s obviousness rejection of independent claims 11 and 21, which Appellants present similar arguments. We also sustain the Examiner’s obviousness rejection of dependent claims 3-6, 9, 12-14, 16-18, and 22-26, which have not been separately argued, and fall with their base claims. 37 C.F.R. § 41.37 (c)(1)(vii). *See In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987). With respect to claim 10, Appellants contend that the additional cited Keith reference does not pertain to the element of claim 1, and thus does not cure the deficiency of the rejection of claim 1, but Appellants do not argue the substance of the rejection pertaining to Keith (App. Br. 16-17).

We disagree with Appellants’ contention. As discussed above, we find no deficiency in the base rejection and further sustain the Examiner’s obviousness rejection of dependent claim 10.

VI. CONCLUSION

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in the combined teachings of the applied references, with Appellants' countervailing evidence and arguments for nonobviousness and conclude that the claimed invention encompassed by appealed claims 1, 3-6, 9-14, 16-18, and 21-26 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

VII. ORDER

We affirm the obviousness rejections of claim 1, 3-6, 9-14, 16-18, and 21-26 under 35 U.S.C. § 103(a).

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136 (a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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